

Docket No.: 6388-0501-0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
BEATRICE TOUMI ET AL. : EXAMINER: L. WELLS
SERIAL NO: 09/533,361 :
FILED: MARCH 22, 2000 : GROUP ART UNIT: 1617
FOR: TIGHTENING AGENT COMPRISING
AT LEAST ONE GRAFTED SILICONE POLYMER

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Examiner's Answer mailed May 5, 2004, Appellants submit the following brief comments.

First, the Examiner states that the method claims in the present application relate to methods of applying compositions containing the claimed silicone polymer to skin, and that any benefits resulting from such application are inherent and not given any patentable weight. (Examiner's Answer at page 4, last paragraph). By mischaracterizing the method claims in this cursory manner, the Examiner ignores the fact that method claims 1, 3, 17-19, 24-29 and 31-33 are directed to methods of reducing wrinkles or signs of cutaneous aging by directly applying the claimed silicone polymer to the wrinkle or sign of cutaneous aging. By requiring the claimed methods to reduce wrinkles or reduce signs of cutaneous aging and by requiring direct application of the claimed silicone polymer to wrinkles or signs of cutaneous aging, Appellants have set forth an intentional purpose which must be satisfied before practiced methods fall within these claims. *See, Jansen v. Rexall Sundown, Inc.*, 68

U.S.P.Q.2d 1154, 1158 (Fed. Cir.2003). Because Kumar does not teach, suggest or in any way indicate the required intentional purpose of reducing wrinkles or reducing signs of cutaneous aging, Kumar cannot render the pending method claims obvious.

Second, the Examiner relies upon *In re Spada*, 911 F.2d 705 (Fed. Cir. 1990) to support her rejections under 35 U.S.C. § 103. Specifically, the Examiner cites *Spada* for the proposition that:

Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present.

(Examiner's Answer at paragraph spanning pages 4-5 and page 6, section 11).

Based on this proposition, the Examiner concludes that Kumar inherently discloses "wrinkle and signs of cutaneous aging reducing effective amounts" of the claimed silicone polymers, thereby rendering the claimed invention obvious. Such legal analysis and reliance upon *Spada* is improper and incorrect given the factual circumstances of this case.

Spada holds that "the discovery of a new property or use of a previously known composition, even when that property and use are unobvious from the prior art, can not impart patentability to claims to the known compositions." *Spada*, 911 F.2d at 708. Thus, only composition claims were at issue in *Spada*: no process claims were at issue.¹

Moreover, *Spada* addresses only anticipation rejections under §102. *Id.* at 707 ("The Commissioner on this appeal concentrates on the rejection for anticipation."). It does not

¹ *Spada* at 708 n. 4 ("All of *Spada*'s claims are composition claims. The issue is not before us of whether *Spada* may have discovered a new use of a known composition, which use may be patentable as a process.").

address obviousness rejections under §103. Thus, the holding in *Spada* does not apply where method claims and/or §103 rejections are at issue.

Here, claims 1, 3, 17-19, 24-29 and 31-33 are method claims which have been rejected under §103, while claims 20-22, 30 and 34-47 are composition claims which have been rejected under §103. Accordingly, the holding in *Spada* is inapposite to the present case.

Given the circumstances of this case, the most relevant case law is *Abbott Laboratories v. Baxter Pharmaceutical Products, Inc.*, 67 U.S.P.Q.2d 1191 (Fed. Cir. 2003), cited by Appellants in the Appeal Brief. In *Abbott*, both composition and method claims were at issue. Both types of claims required the presence of a Lewis acid inhibitor in “an effective amount” to prevent degradation of a drug (sevoflurane) by the Lewis acid inhibitor. The patent specification indicated that water was an acceptable Lewis acid inhibitor. The specification also indicated that the amount of Lewis acid inhibitor necessary to prevent sevoflurane degradation varied upon conditions to which the drug was subject.

During prosecution, Abbott submitted to the patent office information concerning the prior sale of a product containing sevoflurane and 131 ppm water. The Federal Circuit held that the phrase “effective amount” of Lewis acid inhibitor did not exclude 131 ppm despite the prior sale of a product containing this amount of water. In making this ruling, the Federal Circuit reasoned that the plain and ordinary meaning of the phrase “effective amount” was an amount sufficient to be effective for the intended purpose of preventing sevoflurane degradation. *See, Abbott*, 67 U.S.P.Q.2d at 1194.

Here, the claims all require the presence of a wrinkle reducing effective amount or signs of cutaneous aging reducing effective amount of the claimed silicone polymers. Thus,

like the claims in *Abbott*, the present claims require the presence of a claimed compound in an amount sufficient to achieve a desired effect. Moreover, like in *Abbott*, the present specification indicates that the amount of claimed polymer sufficient to reduce wrinkles or signs of cutaneous aging depends on various factors. For example, the present specification indicates that “the amount of grafted silicone polymer present in the composition depends on the tightening effect which it is desired to confer on this composition,” (page 3, lines 14-15), and that the tightening effect varies with the amount of polymer-containing composition actually applied to aged skin. (Page 19, example 7).

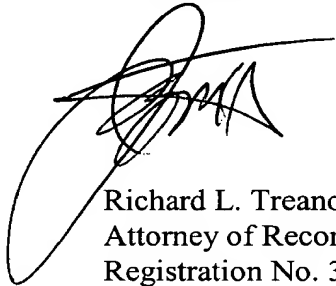
In accordance with *Abbott*, the phrase “effective amount” in the present claims should be given its plain and ordinary meaning: an amount of claimed silicone polymer sufficient to achieve wrinkle reduction or signs of cutaneous aging reduction. Further in accordance with *Abbott*, merely because Kumar discloses the presence of silicone polymers in cosmetic compositions does not mean that this reference discloses an effective amount of the silicone polymers to achieve the desired wrinkle/signs of cutaneous aging reduction, particularly in view of the fact that the present specification indicates that various factors may affect the amount of silicone polymer necessary to be effective for the desired purposes. Thus, Kumar neither teaches nor suggests the invention methods or compositions requiring the presence of a wrinkle or signs of aging reducing effective amount of the claimed silicone polymers.

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Reply Brief

In view of the above remarks and reasons explaining the patentable distinctness of the presently appealed claims over the applied prior art as well as those contained in the Appeal Brief, Appellants request that the Examiner's rejections all be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read 'Richard L. Treanor', is written over a horizontal line.

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